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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/254,148	06/11/1999	JOHN WARWICK ADCOCK	663/35631	6526

23646 7590 06/29/2005

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/254,148

Applicant(s)

ADCOCK ET AL.

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set of extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3624

**DETAILED ACTION**

1. This communication is in response to amendment filed 3/23/2004 and subsequent amendment filed 6/4/2004.

***Response to Amendment***

2. Claims 1, 3, 4, 21, 35, 36, 38, 39, 57 and 58 have been amended. Claims 1-58 are currently pending.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 3, 11, 14, 15, 23, 35, 44, 47, 48, 51, 57 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11 and 44 recite, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Likewise, claims 15, 23, 47 and 51 recite phrase "such as" which renders the claims indefinite.

Art Unit: 3624

Claim 14 recites limitation "wherein said billing information incorporated into a trader card at said trader terminal". Claim 1 recites that the trader terminal includes the billing information. However, the system, functions regardless of whether the billing information is incorporated in the trader card or not. Therefore, the scope this claim is indefinite or unclear.

The term "proximity" in claims 2 and 37 and the term "vicinity" in claims 3, 38, 57 and 58 are relative terms, which render the respective claims indefinite. The terms "proximity" and "vicinity" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 48 recites the limitation "said user card" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 35 is rendered indefinite in view of the structure of the parent claim, which recites the trader terminal and the user terminal as distinct elements which communicate via a communication link. Furthermore, it is unclear how the functionality of the system is affected by

Art Unit: 3624

the location of the user terminal as a part of the trader terminal. It is assumed that the structure and the functionality of the system claim 1 are unchanged due to incorporation the user terminal into the trader terminal.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1, 4-13, 15-34 and 36-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorog (EP 0527639A2) (Gorog) and further in view of Colvin, Sr. (US Pat. 5,825,881) (Colvin).

As per claim 1 Gorog teaches a user terminal receiving and processing user information representative of said user (col. 4 para. (c))..financial transaction terminal (FTT), ..means to input amount of payment information including

Art Unit: 3624

identification of the consumer's account), and receiving and processing said billing information via said link in response to an order (col. 4 para. (c)"..identification of the merchant/service provider sending a bill and the amount the consumer wishes to transmit to the account of the bill sender", noting that the billing information is obtained from the merchant such as bill payment notification which may be received via an e-mail);

A communication network independent of the local communication link enabling said user terminal to communicate with a service provider (see col. 5 L 20-25 the FTT transmits the stored data..via packet switching, broadcasting over radio frequencies or other high speed communication means to the Financial Institution Computer);

Wherein said user terminal transmits said billing information to said service provider over said communication network, whereupon said service provider automatically transfers funds of said user to said trader under the authorization of said user to effect a financial transaction between said user and said trader (col. 7 L 45-col. 8 L 15, which describes processing of the financial transaction wherein funds are automatically transferred from the consumer's account to the merchant account).

Art Unit: 3624

Gorog fails to teach limitations pertaining to trader terminal and communication regarding order for goods/services of the trader from the user terminal to the trader terminal as explained below. However, Colvin teaches these features as follows:

A trader terminal including billing information representative of said trader (Merchant's Storefront 3, which includes itemized price list see col. 3 L 10-15 and col. 2 L 3-6);

A local communication link provided between said user terminal and said trader terminal (link 6 which is a direct communication path 6 from the merchant to the customer, see col. 4 L 24-27);

Wherein an order for goods and/or services of the trader is initiated by transmitting data over said link, using a message protocol, from said user terminal to be received by said trader terminal (see col. 3 L 10-23, sends order data over a HTML protocol to the merchant terminal);

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Gorog in order to provide communication link of the financial transaction terminal (FTT) to the trader terminal to enable purchase of

Art Unit: 3624

goods/ services as disclosed in Colvin because the combined system would also facilitate interactively ordering of goods and services by the user (consumer) from the trader, receive the trader billing information associated with the ordered goods and enable the user to make a desired payment from his account to be credited to the traders account specified in the billing information via a high speed network which is a separate from the communication link over which purchase and billing information is communicated thereby enhancing the speed, security and convenience of the entire business transaction process.

Claim 4: refer to discussion of claim 1.

Claims 5 and 6: The cited prior art fails to teach, however, Official Notice is taken that authorizing financial transaction by a user upon entry of a PIN a user terminal is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention have the financial transaction authorized by the user as claimed in order that the transaction is initiated only with the approval of the user.

Limitation of claim 6, confirmation of the order is also analyzed in view of Official Notice in a similar manner as claim 5.

Claims 7 and 8 : The cited prior art fails to teach, however, Official Notice is taken that transferring reserve funds being transferred based upon certain criteria relating to goods/services purchased by a user is old and well known. For example, it is customary practice to hold the funds related to a purchase transaction in an escrow



Art Unit: 3624

with a third party and release the funds in whole or part to the trader only upon determination by the user that the goods/service are provided in satisfactory condition.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the funds of the user reserved for transfer to the trader based upon one or more criteria or condition because this would ensure that the funds are transferred to the vendor only when the user is fully satisfied according the conditions of the purchase.

Claims 9 : The cited prior art fails to teach, however, Official Notice is taken that transferring escrow funds in installments based on the pre-agreed terms and conditions (billing information) is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide for this feature in order to allow the user to pay the funds in installments as is the customary practice.

Claim 10-12: delivery destination information ..is transmitted to service provider with the billing information (see Colvin col. 2 L 7-9, shipping address, noting that the shipper allocates the goods according to the information provided by the user in a warehouse).

Claim 13: transfer of funds ..takes place upon completion of delivery or acceptance by user (see analysis of claims 7 and 8).

Claim 15: user terminal has data acquisition means..for sensing and receiving said trader billing information. (Gorog see optical reader 1 and laser optical reader 4).

Claim 16: user terminal stores said user information, ..including user identification and account of the user ..(Gorog col. 3 L 29-44, store information presented to it ..).

Claim 17: user terminal has computing processor means for processing said billing information and user information (Gorog, see col. 7, L 29-36, memory capability and capability to execute programmable software [7]..).

Art Unit: 3624

Claim 18: user terminal stores said delivery information..when prompted by said user terminal (see Colvin, col. 2 L 7-9, shipping address).

Claim 19: said user terminal has interface means adapted to transmit any or all of the billing information..to said service provider (Gorog Fig.1 communication means 8).

Claim 20: The cited prior art fails to teach, however, Official Notice is taken that providing confirmation message of completion of financial transaction by a service provider and confirmation of delivery of goods by a shipper is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide for this feature in order to inform the user (or the consumer) regarding the status of his order from appropriate party.

Claims 21 and 22:user terminal is adapted to receive a user card.. (Gorog see col. 7 L 8-11, laser optical reader [4]).

Claims 22-26: The cited prior art does not expressly show that the user has data acquisition means incorporated therein as per claim 23.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the functionality of the user terminal. The receiving and process functions of the user terminals are not functionality related to the data stored on the user card and these functions would be performed the same regardless of the data.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the user terminal receive a user card having features recited in claims 22-23 because such data does not functionally relate to the functions of the user terminal or the trader terminal and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Art Unit: 3624

Claim 27: The cited prior art fails to teach, however, Official Notice is taken that informing an user or a consumer regarding all aspects of a business transaction is old and well known. For example, it is well known that the consumer is informed when the order is received at a service center, funds are withdrawn from or credited to his account, and goods are shipped to his specified address. See previous claims analysis for motivation.

Claim 28-30: The cited prior art fails to teach, however, Official Notice is taken that reversing a transaction is old and well known practice. A trader may initiate such reversal in the event that the purchased product is defective or other complains is received from a consumer who is not satisfied with the product.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide for this feature in order to maintain customer loyalty and trader reputation etc.

Other features recited in dependent claims 29 and 30 are old and well known and are similarly analyzed.

Claims 31 and 32: it is inherent that the trader has access to an account of the trader and user has access terminal has access to the account of user.

Claim 33 and 34: The cited prior art fails to teach, however, Official Notice is taken that transferring amount of taxes collected by sellers to legislative bodies (e.g. local or state governments who imposes sales taxes) is legally mandated and thus old and well known in the commerce.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide for this feature in order to comply with the requirements imposed by taxing authorities.

Method claims 36-47 are analyzed respectively as per system claims 1-7,10-13 and 15.

Art Unit: 3624

Claim 48: wherein the step of processing is carried out by said user terminal..(see Gorog, col. 7 L 29-44 programmed software [7] functionality).

Claim 49: step of reading through reader means ..said trader billing information..( see Gorog, col. 7 L 8-12, "Bill Payer and other identifying data..").

Claim 50: step of informing through said user terminal, said user of all processes being conducted ..(col. 7 L 21-28, "providing information").

Claims 51-56 are analyzed respectively as per system claims 28, 33, 34, 20, 20 and 31.

### **Conclusion**

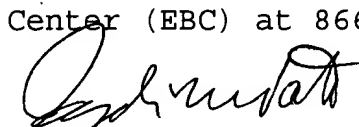
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jagdish N. Patel

(Primary Examiner, AU 3624)

5/25/05